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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,245	03/27/2001	Naoaki Horiuchi	041465-5104	8060

55694 7590 08/03/2006

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,245

Applicant(s)

HORIUCHI ET AL.

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20-July -2006 has been entered.

2. The amendment filed on 20-July -2006 has been received and entered. Claims 1-20 are pending

Claim Objections

3. Claims 1-20 are objected to because of the following informalities:

Claims 1-20 recite in numerous lines, the language of “for”, “using”, “uses”, “used for”, and “so that” all of which constitute intended use making the functionality following not carry any patentable weight since it never actually have to take place. Claims should be amended to recite more direct and positive language such as “is”, “to”, “of”, “that”, “when”/”wherein” “accumulating”, “providing”, or “searching”, etc. Correction is required.

Claims 11-20, all recite in various lines “so as to”, “as”, “functioning as” which constitute intended use and suggest optionally making the functionality following not carry any patentable weight since it never actually have to take place. Claims should be amended to recite

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more direct and positive language such as “is”, “to”, “of”, “that”, “will”, or “being”, etc.

Correction is required.

Claims 11, 13-20, all recite “capable of” which is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required.

The Examiner points to MPEP 2106 [II-C] wherein the claim’s recitation of “capable of” raises the question to Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Office personnel must rely on the applicant’s disclosure to properly determine the meaning of ** the claims. Limitations appearing in the specification but not recited in the claim are not read into the claim; therefore, in this case, the recitation of “capable of” as interpreted in light of the specification provide the “functionality” or “the capability” of the database management system to perform the steps without definite disclosure limiting or excluding any alternative, negative, or even all together suggest actually performing or implementing the functionality that is database management system is capable of.

Therefore, any cited art that teaches the steps otherwise in the alternative can be used to reject the instant application. The computer being capable of perform a function does not mean that it will ever actually perform that functionality (i.e. “capable of” should be clarified and changed to a more definite term such as “configured to” or “is”).

Independent claims 1, 11, and 12, all recite “AV” without previously stating or defining the term. All Acronyms must be spelled out in the claim when first introduced. Correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 preamble recite “**for** making said computer function **as**” is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase “**for**” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “**for**” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997)

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(“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”).

Furthermore, computer programs need to be stored and executed by a computer in order to perform their intended functionality. Claim should be amended to recite more definite and direct language as: “program is recoded and when executed/ or configured to be read by a computer to perform...”.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-4, and 13-14, in various lines, recite, “which is common” which is vague and confusing. Its unclear what is being referenced and what constitute the scope of being “common”? Being common to whom? Common to what? And how is that defined in the first place? Clarification is required.

Claims 1-2, 5, 11-12, and 15-16, recites “an exterior”, and “an exterior as” in various lines, which is vague and unclear. What is exactly being claimed? The display or a remote

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network or the functionality of being outputted to the system? Or the AV hardware itself?

Correction is required.

Claims 12-16, recite "it" in various lines, which is indefinite for failure to point out and distinctly claim the subject matter. What is exactly being referenced by "it"? The computer or the AV information being displayed? Correction is required.

Claims 11-20, in various lines, recite, "as said" or "functioning as" which is indefinite for failure to point out and distinctly claim the subject matter. What is exactly being claimed here?

The system components disclosed or functionality that is similar or could be operated by similar components and if so, why aren't default components that can perform such functionality be claimed instead? The language of "functioning as" suggest that something else is too capable of being substituted to perform the functionality claimed and not necessary the components of this invention. Clarification is required.

Claim 2 recites the limitation "the basis" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "said different and plural" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "said different and plural" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the basis" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 2, line 5, recite and storing said formed corresponding information" without any further indication of where its being stored or what does the storing and if that set of newly formed information is ever used? This recitation is vague and unclear. Correction is required.

Claims 13, and 14, recite the limitation "to input different and plural said example" in line 4. There is insufficient antecedent basis for this limitation in the claim. And its not clear what is meant by plural example? Is it meant to be "examples"? or plurality of examples? Or more of the same example? Correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cluts U.S. Patent No. 5,616,876 ('Cluts').

Cluts discloses:

As to claims 1 and 11,

an AV information accumulating device for accumulating AV (Audio Visual) information, which include any one of audio information, video information and data information associated with at least any one of the audio information and the video information; See 4:36-67;

a characteristic information accumulating device for accumulating characteristic information, which defines said accumulated AV information, for said each AV information; See 11:32-47;

an inputting device for inputting search characteristic information defining said accumulated AV information required to be searched; See 11:34-67; 12:55-67, in accordance with a user's instruction; See 3: 7;

an example inputting device for inputting example information to illustrate said AV information having a characteristic indicated by the search characteristic information when said inputted search characteristic information is not included in said accumulated characteristic information; See 11:61-67; 14:1-27; so that a search operation started by the user's instruction has not been successfully completed; ("so that" is intended use as explained above; but also see 6:4-7);

an extracting device for extracting example characteristic information being said characteristic information, which defines said inputted example information, from said example information; See 14: 28-67; and

an outputting device for searching said AV information associated with said extracted example characteristic information in said AV accumulating device and outputting said searched AV information to an exterior as said AV information associated with said search characteristic information; See 14:27-67.

As to claims 2 and 12,

a corresponding information accumulating device for forming a corresponding information, which associates said extracted example characteristic information to said inputted search characteristic information and storing said formed corresponding information; See 16:40-67; and

a search device for searching said example characteristic information from said characteristic information accumulating device on the basis of said accumulated corresponding information when said search characteristic information is inputted again after said corresponding information is accumulated in said corresponding information accumulating device; See 16:40-67;

wherein said outputting device searches said AV information associated with said searched example characteristic information from said AV accumulating device when said search characteristic information is inputted again and said outputting device outputs said searched AV information to an exterior as said AV information associated with said search

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characteristic information; See 16:40-67.

As to claims 3 and 13,

wherein said example inputting device is used for inputting said different and plural example information and said extracting device extracts said example characteristic information, which is common among said inputted plural example information, from each of said example information.; See 16:40-67

As to claims 4 and 14,

wherein said example inputting device is used for inputting said different and plural example information and said extracting device extracts said example characteristic information, which is common among said inputted plural example information, from each of said example information; See 16:40-67.

As to claims 5 and 15,

wherein said outputting device outputs said AV information associated with said extracted example characteristic information to an exterior as said AV information associated with said search characteristic information by using at least any one of a sound and an image; See 4:50-64.

As to claims 6 and 16,

wherein said outputting device outputs said AV information associated with said extracted example characteristic information to an exterior as said AV information associated with said search characteristic information by using at least any one of a sound and an image; See 4:50-64.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-9 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cluts U.S. Patent No. 5,616,876 ('Cluts').

Cluts discloses the claimed invention except for wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice since it was known in the art that using a voice with a speech to text translator would enable a user to convert his voice to be used as input to activate a computer to perform a common function such as searching for data that would allow the user the freedom of not having to use a keyboard to enter information into the computer for a response.

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Response to Arguments

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of objections and rejection. The arguments were addressed in the Final rejection mailed on 1/20/2006.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-Form 892 for list of Cited References.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Niveen Abel-Jalil', with a stylized flourish at the end.

Niveen Abel-Jalil
August 1, 2006